

Remarks:

4. Claims 1 and 3-6 are rejected under the judicially created doctrine of obviousness-type double patenting. It is the understanding of the applicant that this rejection is temporarily held in abeyance pending the disposition of the claims. If applicant's understanding is inaccurate, please advise the status of this rejection.

6. Claims 1 and 4-6 are rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 2,622,991. Applicants respectfully disagree with the Examiner's characterization of the reference and the rejection based thereon.

The classic test for anticipation, under 35 U.S.C. §102, requires that every limitation in a claim must be present in a single source reference for that reference to "anticipate" the claimed invention.

Claim 1 of the present application recites a heat and pressure consolidated laminate comprising in superimposed relationship: (a) a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin; and (b) a first decorative layer consisting essentially of a leather material.

The '991 patent is directed toward solving the problem of "applying paint or similar coating layers to thermoplastic materials". (Col.1) The invention, according to the '991 patent, is a process for printing on thermoplastics, and in particular to thermoplastic materials of the acrylic type. (Col.1). The composite laminates disclosed within the '991 patent include "one or more layers of such thermoplastic material with a superimposed or an interposed layer or layers of materials... [such as] paper, textiles, leather...". (Col.1)

The '991 patent does not disclose or suggest a core layer containing at least one cellulosic sheet impregnated with a thermosetting resin. The thermoplastic materials, including the acrylic type thermoplastic materials, disclosed within the '991 patent are not the same as or equivalent to the thermosetting resin recited within claim 1.

Applicants enclose herewith definitions of "thermosetting plastics" and "thermoplastic". These definitions clearly illustrate the difference between the two materials.

Accordingly, the subject matter recited in independent claim 1 and dependent claims 4-6

are not anticipated by the '991 patent. Applicants, therefore, respectfully request the rejection be withdrawn and claims 1 and 4-6 be passed onto allowance.

8. Claims 2, 3, and 7 are rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Pat. No. 2,622,991, in view of U.S. Pat. No. 4,255,480.

Applicants respectfully disagree with the Examiner's characterization of the references and the rejection based thereon.

To begin, applicants refer the Examiner to the remarks above relating to the differences between the presently claimed laminate and that disclosed within the '991 patent. For at least those reasons, applicants request the rejection be withdrawn.

In addition, however applicants respectfully submit that there is no motivation to combine the references as suggested by the Examiner. The Examiner indicates that it would have been obvious to a person of skill in the art to combine the core layer of the '480 patent with the laminate of the '991 patent. Specifically, the Examiner states that "Scher teaches that the paper sheet impregnated with phenol formaldehyde would have made the laminate cured better under heat and pressure, and the use of a release sheet would have made the laminate easier to handle (see col.1, ln. 14-16, 62-65)." Applicants respectfully disagree.

When an application is submitted to the Patent and Trademark Office, statute¹ and case law² dictates that the burden of proof is on the PTO to establish a prima facie case of obviousness.³ Once the prima facie case has been established, then the burden of going forward with the evidence to rebut the prima facie case shifts to the applicant.⁴ Only the burden of going forward with evidence to rebut shifts to the applicant, however. The burden of persuasion remains with the PTO.⁵ In this instance, a prima facie case would necessarily

¹ 35 U.S.C. 132.

² See In re Warner, 154 USPQ 173, 178 (C.C.P.A. 1967); In re Oetiker, 24 USPQ 2d 1443, 1447 (Fed. Cir. 1992).

³ In re Piasecki, 223 USPQ 785, 788 (Fed. Cir. 1984).

⁴ In re Carleton, 202 U.S.P.Q. 165,168 (CCPA 1979).

⁵ Ashland Oil v. Delta Resins and Refractories, Inc., 227 U.S.P.Q. 657, 659 (Cir. Fed. 1985). See also In re Fritch, 23 U.S.P.Q.2d 1780, 1783 (Cir. Fed. 1992): "In proceedings before the Patent and Trademark Office, the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. '[The Examiner] can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.' The patent applicant may then attack the Examiner's prima facie determination as

have to first establish that the combined teachings of the '991 and '480 patents render the claimed subject matter obvious⁶, and second provide a suggestion or motivation within the cited references to combine the cited references to arrive at the claimed invention.⁷ The suggestion or motivation to combine the references must not be a hindsight reconstruction of isolated disclosures within the prior art.⁸ Indeed, the lack of an appropriate motivation or suggestion to combine gives rise to an inference that the combination is the product of hindsight.⁹

The passages cited by the Examiner¹⁰ in the '480 patent do not provide the requisite motivation or suggestion to combine the references to arrive at the claimed laminate. The '991 patent discloses a process for printing on thermoplastics. In some embodiments, an ink or other printing material is applied to an acrylic sheet. In other embodiments, a layer of material 13 (e.g., paper) is disposed between thermoplastic layers (e.g., see FIG. 4). The '480 patent, on the other hand, discloses an abrasion resistant laminate that includes a core sheet layer combined with a pattern sheet. One of the objects of the '480 patent is provide a high-pressure decorative laminate that does not contain an overlay sheet. (Col.5, lines 39-41) Consequently, the '480 patent teaches away from the combination suggested by the Examiner. In addition, there is no release sheet claimed in present claims 2, 3, and 7. Hence, the suggested combination to arrive at the claimed laminate is without merit, and appears to be the product of impermissible hindsight.

In the 4/19/2005 office Action, the Examiner states that a hindsight reconstruction is proper "so long as it takes into account only knowledge which was within the level of

improperly made out, or the applicant may present objective evidence tending to support a conclusion of nonobviousness."

⁶ In re Wood, 202 USPQ 171, 174 (C.C.P.A. 1979) citing In re Bozek, 163 USPQ 545, 549-550 (C.C.P.A. 1969).

⁷ ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929, 933 (Fed. Cir. 1984), "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can only be combined if there is some suggestion to do so."

⁸ In re Fritch, 23 USPQ2d 1780 (Fed. Cir. 1992), "[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention", quoting In re Fine, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988).

⁹ In re Rouffet, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998).

¹⁰ Col.1, lines 14-16: "High pressure decorative laminates are conventionally produced by stacking and curing under heat and pressure a plurality of layers of paper impregnated with various thermosetting resins." Lines 62-65: "In actual practice, two laminated stacks are pressed back to back, separated by a coated release sheet that allows the laminates to be peeled apart after separation."

ordinary skill at the time the invention was made, and does not include knowledge gleaned only from the applicant's disclosure". Applicants respectfully submit that In re McLaughlin does not obviate the need for a factual basis to support the rejection.

In addition to the above, claims 3 and 7 recite a decorative layer comprising bonded leather. There is no disclosure in either reference regarding the use of bonded leather. Applicants respectfully direct the Examiner to pages 1 and 2 of the present application wherein the disadvantages of natural leather (e.g., shrinkage, defects, size limitations, etc.) and the advantages of bonded leather (e.g., negligible shrinkage, pre-prepared product, no stretching required, virtually no size limitations, etc.) are described. As the present application describes, the differences between natural and bonded leather are significant for the uses described. For at least these reasons, applicants respectfully submit that the subject matter claimed in claims 3 and 7 is not obvious in view of the cited references.

As applicant has traversed the rejection made by the Examiner, it is respectfully requested that the stated rejection be withdrawn, claims 1-7 be allowed, and the present application be passed onto issuance. A Notice of Appeal and the requisite fee is provided herewith. Consequently, applicants respectfully request the Examiner respond in a timely manner so that the response may be considered within the Appeal brief if necessary. No additional fee is believed due with the present application. In the event a fee is due, please charge our Deposit Account No. 50-3381.

Respectfully submitted,



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